

**REMARKS****Summary of the Office Action**

A new title is required because the title is allegedly “not descriptive.”

Claim 3 stands objected to because of alleged informalities. Correction is required.

Claims 2 and 3 stand rejected under 35 U.S.C. § 112, second paragraph for allegedly being indefinite.

Claims 1-3 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Ueda (JP Patent No. 57-042175) (hereinafter “Ueda”).

Claims 4, 5 and 12 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Ueda as applied to claims 1 to 3 above, and further in view of Yoneta et al. (U.S. Pub. No. 2003/0034496) (hereinafter “Yoneta”).

Claim 13 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Yoneta in view of Ueda.

**Summary of the Response to the Office Action**

Applicant has amended claims 1, 3, 4-5 and 12, and added new dependent claims 15-17, to differently describe embodiments of the disclosure of the instant application and/or to improve the form of the claims. Applicant has canceled claims 2, 6-11 and 13-14 without prejudice or disclaimer. Accordingly, claims 1, 3-5, 12 and 15-17 are currently pending and under consideration. Applicant has also amended the title in response to the Examiner’s requirement at page 3, section 5 of the Office Action.

**Requirement for a New Title**

A new title is required because the title is allegedly “not descriptive.” In response, Applicant has replaced the previous title with a new amended title incorporating the Examiner’s helpful suggested new title as provided at page 3, section 5 of the Office Action. Accordingly, withdrawal of the requirement for a new title is respectfully requested.

**Objection to Claim 3**

Claim 3 stands objected to for alleged informalities. Correction is required. More particularly, the Office Action asserts that claims 2 and 3 are of the same scope. Applicant has canceled claim 2 without prejudice or disclaimer, rendering this assertion moot. In addition, Applicant has amended claim 3 to improve the form of the claim in response to the Examiner’s comments at page 3, section 6 of the Office Action. Accordingly, withdrawal of the objection to claim 3 is respectfully requested.

**Rejections under 35 U.S.C. § 112, Second Paragraph**

Claims 2 and 3 stand rejected under 35 U.S.C. § 112, second paragraph for allegedly being indefinite. The Office Action alleges that the “scope of claim 3 is similar to that of claim 2.” Applicant has canceled claim 2 without prejudice or disclaimer, rendering this rejection moot. Applicant has amended claim 3 to improve the form of the claim in response to the Examiners comments at page 4, section 7 of the Office Action. Applicant respectfully submits that claim 3 fully complies with the requirements of 35 U.S.C. § 112, second paragraph. Accordingly, Applicant respectfully requests that the rejections under 35 U.S.C. § 112, second paragraph be withdrawn.

**Rejection under 35 U.S.C. §§ 102(b) and 103(a)**

Claims 1-3 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Ueda. Claims 4, 5 and 12 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Ueda as applied to claims 1 to 3 above, and further in view of Yoneta. Claim 13 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Yoneta in view of Ueda. Applicant has amended claims 1, 3, 4-5 and 12 to differently describe embodiments of the disclosure of the instant application and/or to improve the form of the claims. To the extent that these rejections might be deemed to still apply to the claims as newly-amended, the rejections are respectfully traversed for at least the following reasons.

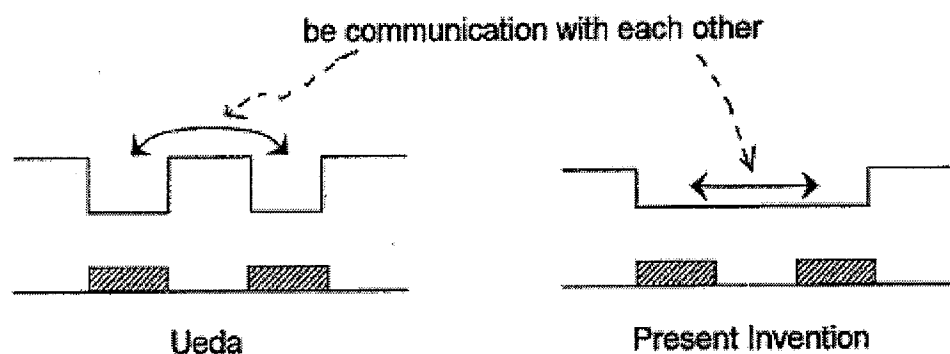
Applicant respectfully submits that Ueda does not teach, or even suggest, an advantageous feature of the instant application's disclosed invention, as described in newly-amended independent claim 1 of the instant application of the depression being formed in the region corresponding to the region where the plurality of photodiodes are formed.

Instead, Applicant respectfully submits that in Ueda, one depression is formed in one region corresponding to one region where one photodiode is formed. Therefore, Applicant respectfully submits that the present invention, as described in newly-amended independent claim 1 of the instant application, differs from the disclosure of Ueda for at least this reason. Applicant respectfully submits that newly-amended independent claim 1 of the instant application is based on the instant application's disclosure at, for example, paragraphs [0072] – [0073] and Figs. 14A-14B.

In addition, Applicant respectfully submits that Ueda does not teach and suggest another advantageous feature of the instant application's invention of adjacent depressions being in

communication with each other, in the semiconductor substrate, as described in newly-amended independent claim 3 of the instant application.

Instead, Applicant respectfully submits that in Ueda, adjacent depressions are in communication with each other, outside the semiconductor substrate. See the diagram provided below in this regard. Therefore, Applicant respectfully submits that the present invention, as described in newly-amended independent claim 3 of the instant application, differs from the disclosure of Ueda for at least this reason. Applicant respectfully submits that newly-amended independent claim 3 of the instant application is based on the instant application's disclosure at, for example, paragraphs [0070] – [0071] and Figs. 13B-13C.



Accordingly, Applicants respectfully assert that the rejections under 35 U.S.C. § 102(b) should be withdrawn because Ueda does not teach each feature of newly-amended independent claim 1 or 3 of the instant application. As pointed out in MPEP § 2131, "[t]o anticipate a claim, the reference must teach every element of the claim." Thus, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a

single prior art reference. Verdegaal Bros. v. Union Oil Co. Of California, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987)."

Furthermore, Applicants respectfully assert that the dependent claims are allowable at least because of their dependence from newly-amended independent claim 1 or 3, the reasons discussed previously, and the following reasons.

For example, the additionally applied reference to Yoneta, with regard to dependent claims 4, 5 and 12, does not cure the deficiencies discussed above with regard to Ueda. As pointed out by MPEP § 2143.03, "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)." Accordingly, withdrawal of the rejections under 35 U.S.C. § 103(a) is also requested for at least the foregoing reasons.

### **CONCLUSION**

In view of the foregoing, Applicant submits that the pending claims are in condition for allowance, and respectfully request reconsideration and timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicant's undersigned representative to expedite prosecution. A favorable action is awaited.

**EXCEPT** for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. § 1.16 and 1.17 which may be required, including

any required extension of time fees, or credit any overpayment to Deposit Account No. 50-0573.

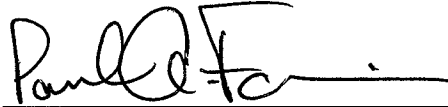
This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

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